

REMARKS

Claims 1-24 are pending.

Claims 1-24 stand rejected under 35 USC §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention.

Claims 1 and 2 stand rejected under 35 USC §102(b) as being allegedly anticipated by Fuller (US 5,768,605).

Claims 3-24 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Fuller (US 5,768,605).

Changes in the Specification:

The specification has been amended for the purpose of improving the readability of the application and are of a clerical, typographical or grammatical nature. In particular, the title “MECHANISM FOR WIRELESS MODEM POWER CONTROL” has been amended to “WIRELESS MODEM POWER CONTROL”. No new matter has been added.

Changes in the Claims:

Claims 1, 4, 9, 12, and 16 have been amended in this application to further particularly point out and distinctly claim subject matter regarded as the invention. No new matter has been added.

Claims 2 and 11 have been canceled.

Rejection under 35 USC §112, second paragraph – claims 1-24

Claims 1-24 stand rejected under 35 USC §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. This rejection is respectfully traversed.

MPEP §2171 identifies two separate requirements: (1) the claims must set forth the subject matter that applicants regard as their invention; and (2) the claims must particularly point out and distinctly define the meets and bounds of the subject matter that will be protected by the patent grant. A lack of antecedent basis may be found if a claim is “indefinite” because “it contains words or phrases whose meaning is unclear”; see MPEP §2173.05(e).

The Office Action alleges that limitations “the insertion” and “the device” in claim 1 lack antecedent basis. Claim 1 has been amended accordingly.

The Office Action alleges that limitations “the insertion” and “the removal” in claims 9 and 16 lack antecedent basis. Claims 9 and 16 have been amended accordingly. The claims now meet the statutory requirements.

Rejection under 35 USC §102(b) – claims 1, 2

Claims 1 and 2 stand rejected under 35 USC §102(b) as being allegedly anticipated by Fuller (US 5,768,605). This rejection is respectfully traversed.

A claim must be anticipated for a proper rejection under §102(a), (b), and (e). This requirement is satisfied “only if each and every element as set forth in the claim is

found, either expressly or inherently described, in a single prior art reference”; see MPEP §2131 and *Verdegaal Bros. V. Union Oil*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1984). A rejection under §102(b) may be overcome by showing that the claims are patentably distinguishable from the prior art; see MPEP §706.02(b).

Fuller describes an apparatus for power management of a PCMCIA Card. A cable connector 80 once inserted into a slot located in the PCMCIA communication card is configured to allow the computer system to detect the presence of the PCMCIA Card. See Abstract. FIGS. 5 and 6 describes two embodiments where a cable connector 80, 280 is needed to enable or disable the power supplied to the PCMCIA Card 40, 280. In the third embodiment, a retractable communication coupler 364 is connected to a switch 350 that activates or deactivates the PCMCIA Card.

In contrast, claim 1 claims a switch that “is configured to generate the inserted signal upon extension of an antenna of the peripheral device and configured to generate the removed signal upon retraction of the antenna.” Fuller describes using an external cable connector 80 to switch the PCMCIA Card. The external cable connector 80 is **not** an antenna of the peripheral device that can be extended or retracted as part of the PCMCIA card.

Fuller describes a “retractable communication coupler 364” that can be connected to a cable connector which may also be connected to an antenna. However, Fuller does not teach or describe “an antenna of the peripheral device”. The embodiment taught in Fuller describes an antenna that is **not** part of the peripheral device. Further, the extension or retraction of the antenna in Fuller does **not** have any effect on the communication coupler 364 since it is the communication coupler that needs to be

extended or retracted and not the antenna. Thus, Fuller does not teach or suggest a switch that “is configured to generate the inserted signal upon extension of an antenna of the peripheral device and configured to generate the removed signal upon retraction of the antenna.”

The presently claimed invention is, accordingly, distinguishable over the cited reference. In the view of the foregoing, it is respectfully asserted that claims 1, 2 are now in condition for allowance.

Rejection under 35 USC §103(a) – claims 3-24

Claims 3-24 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Fuller (US 5,768,605). This rejection is respectfully traversed.

Under MPEP §706.02(j), in order to establish a prima facie case of obviousness required for a §103 rejection, three basic criteria must be met: (1) there must be some suggestion or motivation either in the references or knowledge generally available to modify the reference or combine reference teachings (MPEP §2143.01), (2) a reasonable expectation of success (MPEP §2143.02), and (3) the prior art must teach or suggest all the claim limitations (MPEP §2143.03). See In re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974).

The Office Action asserts Fuller discloses a “retractable communication connector which performs the same function as the antenna.” See paragraph 7, page 4 of the Office Action. Applicant respectfully disagrees. As discussed above, the “retractable communication coupler” still requires an external connection that is not integrated with the PCMCIA card. One would have to constantly attach or detach the connector to the

PCMCIA card thereby rendering the idea of leaving the PCMCIA card in the PCMCIA slot for storage purposes moot. The main advantage is leave the PCMCIA card in the PCMCIA slot without triggering any consumption of power so that one does not have to insert or remove the card from the slot. The present application describes a “retractable antenna” integrated with the card allowing one to avoid carrying a connector, a cable, and an antenna (all of which needed in Fuller).

Applicant therefore submits that the proposed modification of Fuller does not possess all of the claim limitations of claims 3-24. In particular, the proposed modification of Fuller does not teach or suggest a switch that “is configured to generate the inserted signal upon extension of an antenna of the peripheral device and configured to generate the removed signal upon retraction of the antenna.” Also, the proposed modification of Fuller does not teach or suggest “means for simulating an insertion of the peripheral device into host device upon extension of an antenna of the peripheral device; and means for simulating a removal of the peripheral device from host device upon retraction of the antenna of the peripheral device.” See Claim 16.

Thus, Applicant submits that claims 3-24 recite novel subject matter which distinguishes over any possible modification of Fuller.

Conclusion

For all of the above reasons, applicants submit that the amended claims are now in proper form, and that the amended claims all define patentable subject matter over the prior art. Therefore, Applicants submit that this application is now in condition for allowance.

Request for allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
THELEN REID & PRIEST LLP



Thierry K. Lo
Reg. No. 49,097

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Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 282-1810 Direct
(408) 292-5800 Main
(408) 278-8210 Fax